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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,628	01/22/2004	Jan Constant Cool	30394-1116	5051
5179	7590	02/16/2006	EXAMINER	
PEACOCK MYERS, P.C. 201 THIRD STREET, N.W. SUITE 1340 ALBUQUERQUE, NM 87102			SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,628

Applicant(s)

COOL ET AL.

Examiner

Thomas J. Sweet

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/03/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see page 4, filed 01/03/2006, with respect to the rejection addressing claims 2-4, 5 and 7 have been fully considered and are persuasive. The rejection addressing the comments on those claims has been withdrawn. Applicant's arguments regarding claim 1 and 6 have been fully considered but they are not persuasive. The amendment of claim 1 has not rendered the term "distinguishable" definite in scope. Claim 6 was not addressed in response to the rejection.

Applicant's arguments filed 01/03/2006 have been fully considered but they are not persuasive. The claim language does not convey "stores the energy during the walking motion and is made available with a high conversion efficiency to a further spring element that forms part of the prosthesis or orthosis" and is not so limited. Collier is not a modifying reference, so any deficiencies of Elsasser are irrelevant to the rejection based on Collier.

### ***Information Disclosure Statement***

The information disclosure statement filed 1/3/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the prior art cited is a duplicate from the 7/30/04 and 8/30/04 IDSes. It has been placed in the application file, but the information referred to therein has not been considered. The last entry on the 7/30/04 IDS is DE306099, so no further duplicate entry will be considered.

### ***Claim Rejections - 35 USC § 112***

Art Unit: 3738

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: there is insufficient structural relationship (linkages and connection as shown in fig.1 and discussed in [0022]) such that “a second spring element is provided which is arranged to store energy released from the first spring element and to release energy for tensioning the first spring element” could be practiced by one of ordinary skill in the art.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the use of the term “distinguishable” is a relative term is unclear and subject interpretation rendering the scope of the claim indeterminate (i.e. distinguishable not equal distinct, being able to recognize different portions of the same part can be categorized as distinguishable).

Further regard to claim 1, “at least one” first spring doesn’t make sense when a second spring is positively claimed.

With regard to claim 6, claims previously claimed distinct structural members “first spring” and “coupling element” as the same member.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Elsasser (DE 309006). Elsasser discloses a foot prosthesis or orthosis (fig.1) for a member of a human body, comprising limb-forming components, which components are connected by pivoting couplings (5,6,14 etc.), at least one first spring element (22) whose ends are coupled with limb-forming components that are distinguishable (3 and 2) from one another, wherein a coupling element is provided spanning at least two pivoting couplings (e.g. 11 or 13) of a limb-forming component, and a second spring element (24) is provided which is arranged to store energy released from the first spring element and to release energy for tensioning the first spring element (for example as shown in figure 3, when the heel lifts tension from 22 is transferred to 24 and the reverse when the heel would be placed back on the floor as in fig. 4 or 1) and further comprising a lower leg portion (1), a heel portion (2), a front portion of the foot (3) and a toe portion (4), wherein the front portion of the foot at either side ends in pivoting coupling comprising an ankle hinge (6) and a toe hinge (23), respectively, for the coupling of firstly the heel portion (2) and the lower leg portion (1 via 2), and secondly the toe portion (4), and wherein the coupling element (24 and 13) spans the pivoting couplings of the front portion of the foot.

With respect to claim 3, wherein the coupling element (24 and 13) is connected with the toe portion (4) and on the other hand with a selection made from the group consisting of the lower leg portion (1) and the heel portion (2).

With respect to claim 4, wherein the coupling element (24 and 13) is connected with the toe portion (4) and on the other hand with the lower leg portion (1).

With respect to claim 5, wherein the front portion (3) of the foot and the heel part (2) are integrated (brought together by pin 6) to form a whole (unit).

With respect to claim 6, wherein the coupling element (24 and 13) is the first spring element (24).

Claims 1- 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Collier (US 5545234). Collier discloses a foot prosthesis or orthosis (fig. 2) for a member of a human body, comprising limb-forming components, which components are connected by pivoting couplings (20 and 38), at least one first spring element (42 and 29) whose ends are coupled with limb-forming components that are distinguishable from one another (30 and 16), wherein a coupling element is provided spanning at least two pivoting couplings (42 and 29) of a limb-forming component, and a second spring element (27) is provided which is arranged to store energy released from the first spring element and to release energy for tensioning the first spring element (i.e. when compression is increased of 42 and 29 compression on 27 is decreased and visa versa) and further comprising a lower leg portion (16), a heel portion (28 near 14), a front portion (28 near 42) of the foot and a toe portion (30), wherein the front portion (28) of the foot at either side ends in an ankle hinge (20) and a toe hinge (38), respectively, for the coupling of firstly the heel portion (28) and the lower leg portion (16), and secondly the toe portion (30), and wherein the coupling element (42 and 29) spans the pivoting couplings of the front portion of the foot.

With regard to claims 3 and 4, wherein the coupling element (42 and 29) is connected with the toe portion (30) and with the lower leg portion (16).

With regard to claim 5, wherein the front portion of the foot and the heel part are integrated to form a whole (28).

With regard to claim 6, wherein the coupling element (42 and 29) is the first spring element (42 and 29).

With regard to claim 7, A prosthesis or orthosis according to claim wherein the heel portion (28) and the lower leg portion (16) share the ankle hinge (20) of the front portion (28) of the foot, while also being mutually coupled via a second spring element (27).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3738

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tjs



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